REMARKS

Claims 1, 17 and 27 are presently pending. Claim 18 has been canceled without prejudice. Claims 2, 3, 6-16 and 19-26 have been canceled without prejudice for being withdrawn from consideration as directed to non-elected subject matter. Claims 1 and 17 have been amended without prejudice. Support for amended claims 1 and 17 is found in the specification as filed at page 7, lines 21-24 where it is disclosed that R_8 can be aryl, substituted aryl, aralkyl, substituted arylalkyl, heterocycle, substituted heterocycle, heterocyclealkyl or substituted heterocyclealkyl and at page 20, line 18 to page 21, line 4 where particular conditions which the compounds of the present invention are useful for treating or preventing are set forth. New claim 27 has been added. Support for new claim 27 is found in the specification as filed at page 8, line 33 to page 9, line 8 where the chemical structure is set forth and page 20, line 18 to page 21, line 4 where particular conditions which the compounds of the present invention are useful for treating or preventing are set forth. No new matter has been added. Applicants reserve their right to prosecute the subject matter of any canceled, amended or withdrawn claim, or any other unclaimed subject matter, in one or more continuation, divisional or continuation-in-part applications.

I. The Rejection Under 35 U.S.C. §112, First Paragraph

Claims 1, 4 and 17 are rejected under 35 U.S.C. §112, first paragraph, for allegedly not reasonably providing enablement for the treatment of any cardiovascular, metabolic or ischemic condition.

Without in any way conceding the merits of this rejection and solely to advance prosecution, Applicants have amended claims 1 and 17 without prejudice to recite the specific cardiovascular, metabolic or ischemic conditions recited in newly canceled dependent claim 5. Claim 4 has been canceled without prejudice.

In view of the above amendments and remarks, it is believed that the rejection of claims 1, 4 and 17 under 35 U.S.C. §112, first paragraph, cannot stand and must be withdrawn.

II. The Rejections Under 35 U.S.C. §102(b)

Claims 1, 4, 5, 17 and 18 are rejected under 35 U.S.C. §102(b) as being allegedly anticipated by U.S. Patent No. 4,876,252 to Torley *et al.* ("Torley")[1] and U.S. Patent No. 6,114,333 to Davis *et al.* ("Davis"). In particular, the Examiner cites column 2, lines 14-17 and Examples 265 and 266 of Torley and column 7, line 58 to column 8, line 6 of Davis.

Applicants respectfully submit that Davis is not available as prior art to the present application under 35 U.S.C. §102(b). Davis issued as a patent on September 5, 2000 and the present application claims the benefit of U.S. provisional application no. 60/251,904, which was filed on December 6, 2000. Accordingly, because Davis was not patented more than one year before the priority date of the present application, it is not available as prior art under 35 U.S.C. § 102(b). Applicants note that Davis is available as art under 35 U.S.C. § 102(e).

In any event, Davis does not anticipate amended claim 1, amended claim 17 or new claim 27. Davis discloses a class of compounds wherein R_8 is hydrogen or unsubstituted alkyl. Amended claims 1 and 17 do not recite that R_8 is hydrogen, alkyl or substituted alkyl.

The compounds of Torley cited to by the Examiner (*i.e.*, Examples 265 and 266) are those wherein R_8 is hydrogen, unsubstituted alkyl or substituted alkyl. Amended claims 1 and 17 do not recite that R_8 is hydrogen, alkyl or substituted alkyl.

Accordingly, neither of amended claims 1 and 17 are anticipated by Torley or Davis.

New claim 27 recites compounds wherein R_1 is R_7-substituted phenyl and R_2 and R_3 are hydrogen. Neither Torley nor Davis discloses compounds encompassed by new claim 27. Claims 4, 5 and 18 have been canceled without prejudice.

Accordingly, in view of the above amendments and remarks, it is believed that the rejection of claims 1, 4, 5, 17 and 18 under 35 U.S.C. §102(b) cannot stand and must be withdrawn.

III. The Rejections Under 35 U.S.C. §103(a)

Claims 1, 4, 5, 17 and 18 are rejected under 35 U.S.C. §103(a) as being allegedly obvious over Davis in view of U.S. Patent No. 6,361,760B1 to Murata *et al.* ("Murata") and in further view of Adam *et al.*, *J. of Vascular Surgery 30/4*:641-650 (1999) ("Adam").

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[1] The Examiner mistakenly refers to Torley as U.S. Patent No. 4,879,252. This number is incorrect and the correct number is U.S. Patent No. 4,876,252.

To establish a *prima facie* case of obviousness, the following three criteria must be met: 1) there must be some suggestion or motivation to modify or combine reference teachings (*see In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991)); 2) there must be a reasonable expectation of success (*Id.*); and 3) all of the claim limitations of the invention must be taught or suggested by the prior art (*see In re Royka*, 490 F.2d 981, 985 (CCPA 1974)). In the instant case, even assuming *arguendo* that the requisite suggestion or motivation to combine and reasonable expectation of success is present, the above cited references do not teach all of the limitations of the claimed invention. In particular, none of the compounds of amended claim 1 and amended claim 17 are taught or suggested in any of the above cited references. In other words, Davis does not disclose or suggest any compound of amended claim 1 or amended claim 17 and neither Muarata nor Adam cure this deficiency. Thus, each of Davis, Murata and Adam, alone or taken together, do not satisfy the criteria required to establish a *prima facie* case of obviousness.

Claims 4, 5 and 18 have been canceled without prejudice.

Accordingly, in view of the above amendments and remarks, it is believed that the rejection of claims 1, 4, 5, 17 and 18 under 35 U.S.C. §103(a) cannot stand and must be withdrawn.

No fee is believed to be due in connection with this response other than that for the extension of time; however, should any other fee be required, Applicant hereby authorizes that such fee be charged to Deposit Account No. 16-1150.

Respectfully submitted,

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Date: January 9, 2004

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Enclosures